

Atty. Dkt. No. 10015670-1

### REMARKS

This Reply is in response to the Office Action mailed on September 7, 2006 in which claims 1, 2, 4-12 and 14-23 were rejected. For the reasons which follow, Applicants respectfully request that the rejection of such claims be withdrawn. Claims 1-2, 4-12 and 14-23 are presented for reconsideration and allowance.

I. Rejection of Claims 10 and 12 under 35 USC 102(e) Based upon  
Goodman

Section 1 of the Office Action rejected Claims 10 and 12 under 35 USC 102(e) as being anticipated by Goodman et al. US Patent 6,757,071. Applicants respectfully request that the rejection of claims 10 and 12 be withdrawn.

Claim 10 recites a system for optimizing transparency printing. The system includes means for determining whether the document formatting is optimized for transparency printing, wherein the means for analyzing the document comprises means for analyzing printing resolution to be used to print the document. The system further includes means for alerting a user if a document formatting is not optimized for transparency printing.

Goodman fails to disclose or suggest a system for optimizing transparency printing which includes: (1) means for determining whether the document formatting is optimized for transparency printing by analyzing the printing resolution to be used to print the document and (2) means for alerting a user if the document formatting is not optimized for transparency printing. In contrast, the only factors that Goodman appears to analyze are color content and coverage content of the document to be printed. (See column 4, lines 19-25). Nowhere does Goodman disclose analyzing the printing resolution to determine whether document formatting is optimized for transparency printing.

In response to such previous points raised, the Office Action contends that:

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the enhancement of image resolution (performed in Column 4, lines 1-4) is an analysis of printing resolution. Finding resolution to be lacking and subsequently enhancing it is an analysis under any well-known definition of the word.

(Emphasis added) (Office Action dated September 7, 2006, pg. 3).

However, this reliance upon Goodman to reject claim 10 is incorrect for at least three reasons. First, nowhere does this portion of Goodman disclose that a determination or "finding" is made as to whether "resolution is lacking". Although it may be true that a determination of whether resolution is lacking would constitute an analysis under any well-known definition of the word, Goodman does not make this finding.

Second, claim 10 requires more than just an analysis of printing resolution. Claim 10 specifically recites that the analysis of printing resolution to be used to print the document is to determine whether the document formatting is optimized for transparency printing. Nowhere does Column 4, lines 1-4 recite that any alleged analysis is done for the purpose of determining whether the document formatting is optimized for transparency printing. Rather, the recited "enhancement function" which includes image resolution on banded objects appears to be automatically performed regardless of the type of media being printed upon.

Third, Claim 10 additionally recites means for alerting a user if the document formatting is not optimized for transparency printing. In the context of claim 10, this means that the user is alerted if the analyze printing resolution is not optimized for transparency printing. As noted above, the "enhancement function" performed by Goodman appears to be automatic. Nowhere does this cited portion of Goodman disclose that a user is alerted if printing resolution is not optimized for transparency printing. Accordingly, the rejection of claim 10 should be withdrawn. The rejection of claim 12, which depends from claim 10, should also be withdrawn for this reason.

II. Rejection of Claims 1, 2, 4-9 and 11 under 35 USC 103(a) Based upon Goodman and Torpey

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A. Claim 1

Claim 1 recites a method for optimizing transparency printing. The method includes analyzing font sizes used in the document to determine whether formatting of the document is optimized for transparency printing. Claim 11 depends from claim 10 and recites means for analyzing font sizes used in the document

Neither Goodman nor Torpey, alone or in combination, disclose or suggest a method for optimizing transparency printing which includes analyzing font sizes used in a document to determine whether formatting of the document is optimized for transparency printing. As acknowledged by Section 7 of the Office Action dated March 9, 2006, Goodman fails to disclose the step of analyzing the document comprising analyzing font sizes used in the document. As a result, the Office Action attempted to additionally rely upon Torpey by pointing to column 16, line 61-calm 17, line 28 of Torpey and asserting that Torpey discloses the step of analyzing the document comprising analyzing font sizes.

However, Torpey does not disclose analyzing font sizes so as to determine whether formatting of a document is optimized for transparency printing. In contrast, Torpey merely discloses a method by which processes reducing inter-color bleeding (i.e., adjusting borders at black/color interfaces), under-printing and maintaining edge quality (i.e., adjusting borders that printed/non-printed interfaces) can be applied on an object oriented basis (see column 16, line 15-19 of Torpey). That portion of Torpey cited by the Office Action merely indicates that one of the classes of objects comprises text or objects having a certain font size threshold. In other words, if a certain object has a certain font size, a particular process for reducing inter-color bleeding, under printing and/or maintaining edge quality is applied. Like Goodman, discloses nothing about analyzing font size to determine whether the formatted font size is appropriate or optimized for transparency printing.

Moreover, even assuming, arguendo, that it would be obvious to modify Goodman based upon Torpey, the resulting hypothetical combination would not result in the analysis of font size

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to determine whether formatting of a document is optimized for transparency printing. In contrast, at most, the hypothetical combination would only analyze font size to determine which of the pixel management processes described by Torpey should be used to reduce inter-color bleeding, under-printing and to maintain edge quality. Neither Goodman nor Torpey appear to even recognize that to optimize transparency printing, the formatted font size should be analyzed. The only such teaching is found in Applicants' own disclosure. The Office Action's attempt to morph Goodman and Torpey into this claimed feature appears to be impermissibly using Applicants' own disclosure as a blueprint.

In response to such previous points, the Office Action asserts that "Torpey clearly shows and in-depth analysis of font sizes in printing and when combined with Goodman, this analysis could be applied to transparencies." (Office Action dated September 7, 2006, pg. 4).

However, this response to Applicant arguments once again fails to point to or provide any valid motivation or suggestion for applying the analysis of font sizes alleged to be performed by Torpey to Goodman. The mere assertion that the teachings of Torpey "could be applied to" the teachings of Goodman is insufficient to establish a prima facie case of obviousness. (See MPEP 2143.01 FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS). In contrast, what is required is that the prior art must suggest the desirability of the claimed invention. (See MPEP 2143.01). Neither Goodman nor Torpey makes such a suggestion. Thus, the Office Action has failed to establish a prima facie case of obviousness.

Moreover, as noted above, even assuming, arguendo, that would be obvious to modify Goodman based upon Torpey, the resulting hypothetical combination would still fail to disclose analyzing font sizes to determine whether formatting of a document is optimized for transparency printing. Accordingly, the rejection of a 1 and claim 11 based on Goodman and Torpey should be withdrawn. Claims 2 and 4-9 depend from claim 1 and overcome the rejection for the same reasons.

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III. Rejection of Claim 14, 17, 18 and 21 under 35 USC 103(a) Based upon Sugiyama and Murata

Sections 14-17 of the Office Action rejected claims 14, 17, 18 and 21 under 35 USC 103(a) as being unpatentable over Sugiyama US Patent 6,622,625 in view of Murata US Patent 6,111,659. For the reasons which follow, the rejection of such claims should be withdrawn.

Claim 14 recites a method for optimizing transparency scanning which includes determining whether the scanning resolution is appropriate for scanning a transparency. Claim 14 further recites alerting a user if the scanning resolution is not appropriate for scanning a transparency. Claim 21 recites a system for optimizing transparency scanning which includes means for determining whether the scanning resolution is appropriate for scanning a transparency and means for alerting a user if the scanning resolution is not appropriate for scanning a transparency.

Neither Sugiyama nor Murata, alone or in combination, disclose either a method or a system where a determination is made as to whether the scanning resolution is appropriate for scanning a transparency and where a user is alerted if the scanning resolution is not appropriate for scanning a transparency. In contrast, Sugiyama merely discloses an intelligent printer driver for determining the type of media being printed upon. Murata merely discloses an apparatus and method by which a scan job command file for a digital copying machine may be created or modified using a remote personal computer.

In rejecting claims 14 and 21, the Office Action mischaracterizes both Sugiyama and Murata. The Office Action asserts that Sugiyama teaches analyzing a document to be scanned to determine whether the document is a transparency document and determining whether the scanning resolution is appropriate for scanning a transparency where the document is determined to be a transparency document. (Office Action dated September 7, 2006, pgs. 6-7). In making this assertion, the Office Action refers to Column 6, line 24-30; Column 6, line 5-57 of the Sugiyama. This characterization of Sugiyama is incorrect for at least two reasons.

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First, Sugiyama discloses nothing about analyzing a document to be scanned. In contrast, Sugiyama discloses that the medium to be printed upon is scanned to determine whether a medium to be printed upon is a transparency. By determining the type of media being printed upon, Sugiyama is able to select a printing mode most suitable for the medium. (See Column 6, lines 50-57).

Second, nowhere does Sugiyama disclose determining whether a scanning resolution is appropriate for scanning a transparency. Sugiyama does not even mention a scanning resolution. Rather, Sugiyama merely discloses moving a carriage across the medium and sensing characteristics of the medium to be printed upon using two sensors.

The Office Action asserts that Murata discloses alerting a user if the scanning resolution is not appropriate for scanning a transparency and refers to Column 10, line 57-Column 11, line 7. However, Murata discloses nothing about alerting a user if scanning resolution is not appropriate for scanning a transparency. In contrast, Murata merely discloses that if a user enters a scanning resolution in the dialog box (on the remote personal computer) that is outside of the minimum and maximum bounds for the digital copier as defined in the read function information file (the values of which are taken from the digital copier), the user is notified. Notifying a user as to whether his or her selected scanning resolution is within the capability of a scanner is starkly different from notifying a user whether the current scanning resolution is not appropriate for scanning a transparency.

Moreover, it would not be obvious to combine Sugiyama and Murata as asserted by the Office Action. In the rejection, the Office Action asserts that "Sugiyama and Murata are combinable because they are both from the scanning field of endeavor." (Office Action dated September 7, 2006). This is not correct. As noted above, Sugiyama has nothing to do with the "scanning field of endeavor". Sugiyama discloses an intelligent printer driver for determining the medium to be printed upon and for selecting a printing mode most suitable for the medium. (See Sugiyama, column 6, line 50-57). Accordingly, the rejection of claims 14 and 21 based upon

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Sugiyama and Murata should be withdrawn. The rejection of claim 17 and 18, which depend from claim 14 should be withdrawn for the same reasons.

IV. Rejection of claims 15 and 22 under 35 USC 103(a) Based upon Sugiyama, Murata and Ellson

Section 18 of the Office Action rejected claims 15 and 22 under 35 USC 103(a) as being unpatentable over Sugiyama US Patent 6,622,625 in view of Murata US Patent 6,111,659 and further in view of Ellson US Patent 5,381,526. Claims 15 and 22 depend from claims 14 and 21, respectively, and overcome rejection for the same reasons discussed above with respect to claims 14 and 21.

V. Rejection of claims 16 and 23 under 35 USC 103(a) Based upon Sugiyama, Murata and Stewart

Section 19 of the Office Action rejected claims 16 and 23 under 35 USC 103(a) as being unpatentable over Sugiyama US Patent 6,622,625 in view of Murata US Patent 6,111,659 and further in view of Stewart et al. US Patent 5,283,671. Claims 16 and 23 depend from claims 14 and 21, respectively, and overcome rejection for the same reasons discussed above with respect to claims 14 and 21.

VI. Rejection of claims 19 and 20 under 35 USC 103(a) Based upon Sugiyama, Murata and Goodman

Section 20 of the Office Action rejected claims 19 and 20 under 35 USC 103(a) as being unpatentable over Sugiyama US Patent 6,622,625 in view of Murata US Patent 6,111,659 and further in view of Goodman et al. US Patent 6,757,071. Claims 19 and 20 depend from claim 14 and overcome rejection for the same reasons discussed above with respect to claim 19.

Moreover, Claim 19 recites the additional step of suggesting an alternative scanning resolution where the scanning resolution is not optimized for transparency scanning.

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The Office Action acknowledged that neither Sugiyama nor Murata discloses the step of suggesting an alternative scanning resolution were the scanning resolution is not optimized for transparency scanning. As a result, the Office Action attempted to additionally rely upon Goodman and asserted that Goodman discloses such in Column 5, line 48-Column 6, line 3; Figure 6.

However, this is not correct. As noted in the response to the previous Office Action dated March 9, 2006, Goodman says nothing about scanning documents. Goodman says nothing about adjusting scanning resolution. Moreover, Goodman is not from the transparency field of endeavor. Rather, Goodman is limited to an intelligent printer driver. In response to such previous points made with respect to claim 14, the Office Action found Applicants' arguments to be persuasive. (See Office Action dated September 7, 2006, pg. 2). Accordingly, the rejection of claims 19 and 20 should be withdrawn for this additional reason.

#### VII. Conclusion

Claims 1-2, 4-12 and 14-23 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers



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submitted herewith, Applicants hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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